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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,982	03/11/2004	Debasis Majumdar	81794BLMB	5000

7590

07/25/2006

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EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/797,982
Filing Date: March 11, 2004
Appellant(s): MAJUMDAR ET AL.

MAILED

JUL 25 2006

GROUP 1700

Lynne M. Blank
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/5/2006 appealing from the Office action mailed 10/18/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,207,361

GREENER et al.

3-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Greener et al (6,207,361)

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Greener et al disclose an imaging element comprising a layer of biaxially oriented sheet adhered to the bottom surface of a base wherein said biaxially oriented sheet adhered to the bottom surface has a surface roughness average of between about 0.30 to 2.00 microns. Any suitable biaxially oriented polyolefin sheet may be used for the sheet on the topside of the laminated base of the invention, but PET is preferred. The composite biaxially oriented sheets

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are preferred and are conveniently manufactured by coextrusion of the core and surface layers, followed by biaxial orientation. The base material comprises a polymeric polyether antistat (see examples in column 7), comprises a small amount of a compatibilizer (column 7, lines 35-37), and is stretched to a ratio of between 1.5 and 4.5 times the original dimensions (column 7, lines 9-25). Given the teachings of the reference, the instant claims are anticipated.

(10) Response to Argument

Appellant has argued that the Greener et al reference fails to teach that the extruded polymer sheet has a surface having a roughness of greater than $0.3R_a$, and has been stretched by a ratio of at least 3:1. Firstly, the examiner points out an error made in the body of the rejection. The examiner wrote that “the biaxially oriented polymer sheet adhered to the bottom surface *has* a surface roughness..., however the examiner had intended to state that the “bottom surface *would have* a surface roughness...”. The examiner addressed this in the arguments in the final office action response to arguments section by stating that “While the reference does not specifically discuss the limitation for the surface roughness, the material of the reference (see examples) comprises the same polymers/ materials that are employed in the examples of the instant specification, thus the examiner takes the position that the material of the Greener et al reference does have a bottom surface having a surface roughness meeting the instant claim limitations.” The material of the reference employs a compatibilizer of polyether-block-copolyamide in a polyethylene terephthalate sheet that has been stretched in a ratio of 3.3 (see column 8, paragraph 1 of the reference), thus the sheet is prepared in the same manner as the

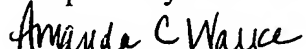
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instantly exemplified materials. The sheet of the instant invention is either a polyethylene or polypropylene (both are employed in the examples), and the specification teaches that preferred polyethylenes include polyethylene terephthalate. While the reference does have an antistatic layer on top of the PET sheet on the backside, this layer also comprises PET along with the conductive polymer and a compatibilizer, and has been stretched at a ratio of 3.3 as well. Therefore, the examiner has taken the position that since the material of the reference is employing the *same* materials, and is prepared (stretched) in the *same* manner and ratio, that the base of the reference on the bottom and top surfaces would inherently meet the instant claim limitations for the surface roughness. The appellant has pointed to a few Kubota et al references which are stated to demonstrate that “although the materials are the same or similar to the present claims, the roughness falls outside the present claims. Therefore, the roughness is not an inherent property of the materials.”. The examiner is unpersuaded by this argument, because when one takes the *same* materials and performs the *same* treatments, the end result will be the *same*, and in the case of Kubota, the material are *similar*, not the *same*. Note that the polymers employed in the Kubota references are a polyester and polyetherimide, not the PET employed in the Greener et al reference (and the instant invention/ examples).

In summary, given that the Greener et al reference employs the same polymers/ materials and prepares the base sheet (by stretching) in the same manner as that in the instant invention, the material would inherently meet the instant claim limitations for the surface roughness.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Amanda C. Walke

Conferees:

Cynthia Kelly 

Pat Ryan

